

Hendricks describes methods of delivering programming and suggesting programming to subscribers of a television system. More specifically, Hendricks describes a menu driven system for suggesting television programs to users. The Examiner admits that Hendricks fails to disclose a receiver that is capable of checking stream type to determine which streams may be used by the receiver prior to transmission of the broadcast stream.

Accordingly, the Examiner must rely upon MacInnis to show a receiver that is capable of checking stream type to determine which streams may be used by the receiver. MacInnis, describes a system for downloading software, such as video games, to terminal. The Examiner states that: “it would have been obvious to combine the broadcast delivery system as taught by Hendricks, utilizing the receiver compatibility table, as taught by MacInnis, for the purpose of selectively downloading different versions of software modules and data modules to a variety of potentially different terminal types.”

The Examiner’s stated motivation fails to support the combination of Hendricks and MacInnis. Specifically, Hendricks fails to describe any need for downloading different versions of software modules as taught by MacInnis. In *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), the Federal Circuit stated that the specific motivation to combine references must appear in the record. Further, the Examiner can not simply substitute a reference to a general level of skill in the art for this motivation:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

The burden imposed by *Lee* is not an impossible burden, as explained by the court in *In re Thrift*, 298 F.3d 1357, 1364-65, 63 USPQ2d 2002 (Fed. Cir. 2002), with respect to the references relied on by the Board in that case:

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by *In re Lee*. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan

would have “found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs.” Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that “allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment.” Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that “there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art.” ’237 patent, col. 4, ll. 34-38.

Based on *Lee* and *Thrift*, the appropriate question to ask again at this point in the analysis is: why, based on Hendricks, would a person of ordinary skill in the art have had *any* reason to look at MacInnis and to use MacInnis’ disclosure in conjunction with Hendricks to arrive at the claimed invention? There is only the same, reasonable answer: impermissible hindsight reliance on applicant’s disclosure and claims as a roadmap to choose MacInnis.<sup>1</sup> Since the Examiner has failed to provide proper motivation for combining Hendricks with MacInnis, this rejection should be withdrawn.

Further, even if one were to combine Hendricks and MacInnis, they would not produce the claimed invention. MacInnis, as stated by the Examiner, discloses a system for determining what software modules in a stream are compatible with a system. MacInnis fails to disclose different stream types, only some of which are compatible with the system. MacInnis also fails to disclose a system for determining what content streams may be utilized by a system as claimed. Accordingly, the rejection of claim 6, should be withdrawn for this additional reason.

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<sup>1</sup> Applicant recognizes that an Examiner cannot search prior art to use in examining a patent application without reading the application and its claims first. That much “hindsight” is permissible and expected in the examination process. However, that is as far as hindsight in the examination process can go. Once the Examiner finds prior art that appears to be relevant based on the limited amount of hindsight that is permissible, *Lee* and *Thrift* require the Examiner to point to *evidence* within the prior art references themselves as to why persons of ordinary skill in the art would have been motivated to combine the disclosures so as to arrive at the claimed invention. Applicant’s position rests on the Examiner’s failure to produce and rely on objective evidence of motivation in the prior art itself.

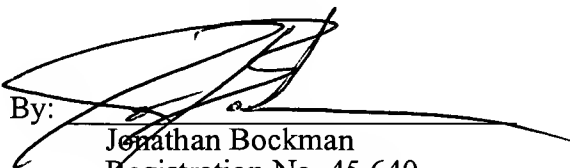
Claims 7-11 stand rejected under 35 USC 103(a) as being unpatentable over Hendricks in view of Knudson and MacInnis. This rejection is respectfully traversed. Claims 7-11, like claim 6, all include a receiver that is capable of checking stream type to determine which streams may be used by the receiver. As stated above, the Examiner relies upon the combination of MacInnis with Hendricks to show this claimed capability. However, since as previously detailed, the Examiner has failed to provide proper motivation for combining MacInnis with Hendricks and the combination of Hendricks and MacInnis fails to disclose a system for determining which content streams may be utilized by a system as claimed, the rejection of claims 7-11 should be withdrawn.

Applicants recognize the allowance of claims 1-5. Since claims 6-11 are allowable for the reasons given above, a notice of allowance allowing all pending claims in this application is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952. 559442000303.**

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